

17 Feb 2004 Preliminary Amendment to Specification is Resubmitted Here

The applicant therefore is resubmitting the 17 Feb 2004 Preliminary Amendment with revised formatting. The original submission is made in the form of a mark-up specification and a clean copy with formatting discrepancies in the presentation that are corrected here. The 17 Feb 2004 preliminary amendment is not believed to be “extensive”, nor was it described as “extensive” in the Examiner’s office action, which is relied upon here. A substitute specification is therefore optional. The method of amendment chosen here is “replacement paragraph” markup.

This practitioner respectfully requests that the amended specification be entered. The amendment is believed to be in condition for entry prior to examination and PG-PUB publication and it is respectfully requested that it be so entered without delay -- before publication or examination.

There is no dispute that the Director has the authority to refuse preliminary amendment under certain circumstances, however, said authority is discretionary and reasonably should not be exercised where lack of timeliness, non-responsiveness, or the heart of the merits do not compel it. The Examiner conceded that an amendment ready for entry in part is properly entered in part.

For the record, regarding priority of disclosure, the “Mark-up” copy of the specification submitted on 17 Feb 2004 shows all changes by strikethrough, underline and bracketing, and the document is clearly labelled. The “mark-ups” themselves (paragraph by paragraph) are transferred into this document without further amendment except to format.

Other issues raised in the notice now turn out to be non-issues. Earlier submissions of a duplicate drawing set and abstract were for convenience only, and were not amended. The transmission letter of 29 Jul 2004, for example, was pointedly marked as not an amendment and careful limiting explanation was given on the transmittal coverpage. In the Examiner’s office action, the Notice of Noncompliant Amendment cites the 29 Jul 2004 submission as an amendment. That is not so. It was a response to a Formalities Letter, nothing more.

Please note that the Drawings and Abstract are as originally submitted without amendment. These clarifications are offered to be helpful, because it reduces what seems a rather large snowball to a series of fairly simple steps which are mapped out here in detail.

17 Feb 2004 Preliminary Amendment to Claims is Resubmitted Here

Amendments to the claims were made, and 6 new claims were added on 17 Feb 2004. There should be no issue that the Preliminary Amendment dates to 17 Feb 2004, roughly 2 weeks following the date of filing on this case, and is effectively a part of the filing. In addition to the markup, a list of all pending claims was submitted in the form of a clean copy without status indicators. At issue here is format.

This submission is believed to be a full response to the Notice of Noncompliant Amendment with respect to the formatting of the 17 Feb 2004 preliminary amendment. The relevant sections are titled:

Page 9	Response to Office Action, Notice of Noncompliant Amendment, re. Preliminary Amendment to Claims Dated 17 Feb 2004
Page 20	Response to Office Action, Notice of Noncompliant Amendment, re. Preliminary Amendment to Specification Dated 17 Feb 2004

Examiner's Notice of Noncompliant Amendment is Defective

Examiner requires drawing amendments be resubmitted. But there were no drawing amendments. No mark-up copies of drawings for amendment were submitted.

Examiner requires new paragraphs not be underlined. But there were no new paragraphs.

Examiner noted amendment did not contain "markings". However, mark-ups to claims and specification were clearly provided.

Orally, the Examiner communicated in argument that the substitute specification of 17 Feb 2004 was not labelled substitute specification, and was instead treated as a preliminary amendment under section CFR 1.121. The Examiner noted, “Sub spec should include all the above mentioned in A and B”. That is not proper policy. To the contrary, new paragraph underlining is proper, not improper, in a substitute specification. Moreover, there were no new paragraphs, so the comment was apparently without foundation. No statutory requirement was discovered or pointed out requiring an applicant to select “substitute specification” versus “paragraph replacement” when making preliminary amendment to the specification. In fact, there is some risk in doing so, should the Office determine that the changes are “extensive,” an ill-defined threshold. In general, when an application appears to be an application, it is treated as such. An amendment that has the legal appearance of an amendment, distinctly noting any changes, retains its legal force, regardless of its font or format. The applicant should not be simply instructed to “start over”.

The Examiner orally advised this practitioner that new paragraphs must be marked with a status indicator when making an amendment. For purposes of this submission, new paragraphs are marked with a status indicator, as for example, (NEW) Paragraph We dodge this bullet. Again, there are no new paragraphs in the amendment of 17 Feb 2004.

The amendments to Specification and to Claims are separable from each other. The compliance of any one amendment or amended section stands separately from the compliance of another. As a matter of practice, partially compliant amendments may be entered to the extent that they are compliant.

Amendment was Made Within 3 Months of Date of Filing

A review of the regulations indicates that special status is afforded amendments made in the first 3 months following filing. If the applicant is to be his own lexicographer, then the preliminary amendment process is essential. The public notice value is also substantial. For the record, we assert that the enclosed material constitutes a timely Preliminary Amendment submitted 17 Feb

2004, ie. within 3 mo post filing and is hence entitled to special status per MPEP 714.03(b)(2), "A preliminary amendment will not be disapproved if it is filed no later than three months from the filing date of an application under 1.53(b)."

Initially, the inventor had planned manufacturing last year and my instructions were to work on a Petition to Make Special. The prosecution was designed around that. Amendments were offered so as to clean up the application for allowance. However, following the inventor's injury last summer, any special urgency has become a historical non-event. Nonetheless, I believe that the preliminary amendment made on Feb 17 2004 is entitled to pre-grant publication because it was submitted within 3 months of filing (CFR 1.115(b)3i), and because the clarity of the "mark-up" language of Specification (and Claims) provided at time of its submission is undisputed. Because of the current status, re-submission of by EFS seems impossible. Importantly, there seems to be a sort of "lumping together" and cross-over in the reasoning provided in examiner's notice of 22 Dec 2004 that is not borne out by closer examination of the parts. Note the inappropriate comment in the office action regarding underlining and substitute specifications, and the absence of amended drawings despite Examiner's comment that suggests amended Drawings have to be re-submitted. The examiner's action contains material error in fact and departure from policy and procedure. I concede that the action is correct in part.

If the initial fault is mine, so be it. A kingdom can be won or lost for a horseshoe. But things just snowballed after that. Please consider that this submission today, less than 1 week after receipt of a Notice of Non-Compliant Amendment, is a thorough and speedy effort to promptly respond to the notice so that examination can proceed and the status of the Preliminary Amendment can be cleared for PG-PUB and examination. Clearly the issue is not one of lack of responsiveness, but rather one of obsolete MPEP documents in print, labelled current as of May 2004 , an understandable confusion concerning current formatting standards that seems in part shared by the Examiner and that is remedied best by entry of the amendment without further comment.

This has been educational. Thank you for your assistance.

Respectfully submitted,



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Dated: 12 JAN 2005

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Attachments: pages 8 - 40